

Remarks

Claims 13-20, and 25 are pending in the application. The position set forth in the Office Action has been carefully considered. Reconsideration is respectfully requested.

I. REJECTIONS OF CLAIMS 13-20, AND 25 UNDER 35 U.S.C. § 103

Claims 13-20, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable based on a combination of U.S. Patent No. 6,226,512 (Macaulay) and U.S. Patent No. 4,759,897 (Tolino). All pending claims are believed to be allowable for at least the following reasons. Withdrawal of the rejection is respectfully requested.

The inventions defined in independent claims 13-20, and 25 are related to a method and computer-readable media for displaying a soft key label. Specifically, independent claim 13 recites "storing a plurality of soft key label sets wherein one of the plurality of the soft key label sets has a function in a particular context and includes a text string." Claim 13 further recites, *inter alia*, "displaying the one of the plurality of the soft key label sets on the display such that the text string corresponds to a physical button on the telephone," and "changing the one of the plurality of the soft key label sets to another of the plurality of the soft key label sets when the context changes." Claim 13 requires, *inter alia*, that "while the one of the plurality of the soft key label sets is being changed, the physical button is deactivated. Independent claim 25 also recites features similar to those of claim 13.

The Office Action admits that Macaulay fails to teach deactivating a physical button. The Action cites Tolino to cure the deficiency of Macaulay as describing deactivation of a keyboard of a computer. Applicant respectfully disagrees.

Most importantly, Tolino fails to teach the claimed condition, i.e., "while the one of the plurality of the *soft key label sets is being changed*." Tolino's triggering event for disabling the keyboard is the actuation of one of the function keys (column 11, lines 60-64). As illustrated in FIG. 20, Tolino merely describes turning off all soft keys and then turning on soft keys for the main menu. Upon actuation of one of the function keys, the keyboard is disabled. Nothing in Tolino suggests the claimed condition, i.e., *a soft key label is being changed*, as a triggering event. In summary, Tolino merely shows the latter part (or the consecutive clause) of the claimed element, i.e., "the physical button is deactivated."

On the other hand, even assuming, *arguendo*, that Macaulay suggests changing a soft key icon, Macaulay merely shows the conditional part (or the "while" clause) of the claimed element, i.e., "while the one of the plurality of the soft key label sets is being changed." Therefore, the

Office is essentially employing two separate teachings, and applying them to a single conditional act.

Applicant respectfully submits that such a piecemeal analysis on a single claimed element cannot be legally permissible and thus unsupportable. The conditional term "while" provides a strong link between the conditional part and the consecutive part of the claimed element. In other words, such a term explicitly defines a close relationship between the two inseparable portions of a single claimed element. If such a piecemeal rejection were permissible, any inventive electrical circuit would be rejected based on a combination of patents disclosing various electrical parts such as transistor, resistor, capacitors, inductors, etc. As such, it is respectfully submitted that the current rejection based on Macaulay and Tolino should be withdrawn.

In view of the foregoing, independent claims 13 and 25 are believed to be patentable over the cited art. The Examiner's rejections of the dependent claims are respectfully traversed. However, to expedite prosecution, all of these claims will not be argued separately. Other claims each depend either directly or indirectly from independent claims 13 and 25, and therefore, are respectfully submitted to be patentable over cited art for at least the reasons set forth above with respect to claims 13 and 25.

II. CONCLUSION

Applicant believes that all pending claims are in condition for allowance, and respectfully requests a Notice of Allowance at an early date. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 510-663-1100, ext. 245.

Respectfully submitted,
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